

Attorney Docket: 112.P14070

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REMARKS

The present patent application has been reviewed in light of the office action, dated April 27, 2006, in which claims 4 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-2, 4 and 9-18 are rejected under 35 U.S.C. § 103(a) as being anticipated by Boyd et al., U.S. Patent No. 6,166,831 (hereinafter "Boyd") in view of Scott, U.S. Patent No. 6,928,195 (hereinafter "Scott") and in view of Ogasawara, U.S. Patent No. 4,409,625 (hereinafter "Ogasawara"). Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyd in view of Scott, Ogasawara and Teeter, U.S. Patent No. 4,451,030 (hereinafter "Teeter"). Claims 5-6 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyd in view of Scott, Ogasawara and Shimizu et al., U.S. Patent No. 5,777,308 (hereinafter "Shimizu"). Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyd in view of Scott, Ogasawara, Shimizu, and Teeter. Reconsideration of the above-referenced patent application in view of the foregoing amendments and following remarks is respectfully requested.

Claims 1-18 are pending. Claims 4 and 8 have been amended. Assignee has amended claims to more clearly delineate intended subject matter. The amendments to the claims are made without prejudice or disclaimer, and Assignee believes that none of these claim amendments constitute narrowing amendments. Accordingly, Assignee does not intend to surrender claimed subject matter by submission of the above amendments and no prosecution history estoppel should apply.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 4 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 4 and 8 have been amended to overcome this rejection.

Rejections under 35 U.S.C. § 103(a)

Claims 1-2, 4 and 9-18 are rejected under 35 U.S.C. § 103(a) as being anticipated by Boyd in view of Scott and in view of Ogasawara. Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyd in view of Scott, Ogasawara and Teeter. Claims 5-6 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyd in view of Scott, Ogasawara and Shimizu. Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyd in view of Scott, Ogasawara, Shimizu, and Teeter.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." MPEP § 2143. Assignee respectfully submits that the Examiner has not established a *prima facie* case of obviousness. The cited patents do not teach or suggest all the limitations of the aforementioned claims.

For example, Boyd, Scott, Ogasawara, Shimizu, and Teeter, either alone or in combination, do not disclose or suggest "using the m rows of sensors concurrently to scan m document portions during the exposure time wherein each of said m document portions are not adjacent to any other of said m document portions" (emphasis added) as claimed in claims 1, 5, and 9. Claims 11, 13, 15, and 17 are similarly not taught nor disclosed by the above-mentioned patents.

Scott does not disclose the scanning of documents, but rather discloses a system for imaging palms. There is absolutely no teaching in Scott of scanning m document portions where each of the m document portions are not adjacent to any other of the m document portions, as claimed in claims 1, 5, and 9. Assignee further disagrees with Examiner's contention that the various image portions disclosed by Scott are not adjacent to each other. As disclosed at column 1, lines 57-58, one nutating position varies from the next by a fraction of a pixel amount.

Also, Assignee respectfully contends that there is no teaching or suggestion to combine Scott and Boyd. It is well settled that if the "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) Clearly, combining the motor-driven scanning apparatus of Boyd with the imaging system of Scott, if possible, and Assignee does not concede that such a combination is possible or would have a likelihood of success, would yield a system that could not be used to image palms. Further, because Scott teaches combining multiple separate images (one image per nutating position) to produce a higher-resolution image, such a system would result in a document being scanned multiple times in order to produce the higher-resolution

image. Moving a document through a scanner multiple times (once for each nutating position) to produce a higher-resolution image would clearly result in a large degradation in scanning speed. Further, the addition of a nutating mirror and associated circuitry would frustrate the stated goal of Boyd to provide a higher-resolution linear array image sensor that is lower in cost (see column 1 line 35-39 of Boyd). For at least these reasons, there is no motivation or suggestion to combine Boyd and Scott.

Because none of the Boyd, Scott, Ogasawara, Teeter, and Shimizu patents disclose the above claim elements, and further because there is no suggestion or motivation to combine the patents, claims 1-18 are believed to patentably distinguish from the cited patents. It is, therefore, respectfully requested that the Examiner withdraw the rejection as to these claims.

It is noted that claimed subject matter may be patentably distinguished from the cited patents for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

CONCLUSION

In view of the foregoing, It is respectfully asserted that all of the claims pending in the present patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500.

Reconsideration of the present patent application and early allowance of all the claims is respectfully requested. Please charge any underpayments or credit any overpayments to deposit account no. 50-3703.

Respectfully submitted,

Dated: 7/27/06

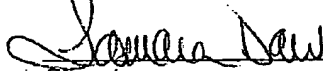
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